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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,760	02/27/2004	Neil Sater	W005 100096	8478
32662	7590	06/15/2006	EXAMINER	
FELIX L. FISCHER, ATTORNEY AT LAW 1607 MISSION DRIVE SUITE 204 SOLVANG, CA 93463			LAMBELET, LAWRENCE EMILE	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/788,760

Applicant(s)

SATER, NEIL

Examiner

Lawrence Lambelet

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .           |

Continuation of Attachment(s) 6). Other: Abstract from Ulrich, Polyurethanes, "Encyclopedia of Polymer Science and Technology", Data Sheet for Product Z-6644 from Development Associates, Inc., MSDS for Product Z-6644A from Development Associates, Inc..

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I (claims 1-10) in the reply filed on 11/03/2005 is acknowledged.

### ***Drawings***

The drawings are objected to because the specification does not agree with the figures as labeled. References to Fig 4 at lines 27-28 on page 2 and line 5 on page 4 describe Fig 4 as having a wave pattern. This would appear, instead, to be what is illustrated in Fig 5. Similarly, references to Fig 5 at lines 29-30 on page 2 and lines 19-20 on page 4 seem to belong to the longitudinal arc of Fig 4. This can be easily corrected by switching the drawing labels.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: "32" for "cap block", mentioned at line 25 on page 4.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: The word "polyethylene" is misspelled at line 12 on page 3. Appropriate correction is required.

### ***Claim Objections***

Claim 10 is objected to because of the following informalities: The claim recites "Styrofoam" for the resilient dams which is inconsistent with the disclosure of the specification. Styrofoam is derived from styrene and not polyethylene, as recited at lines 10-13 on page 3. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 6 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Whiting (U.S. Patent 7,014,726).

Whiting discloses a method for producing a contoured laminated slate as recited in claim 1. Applicant should refer to the whole document with particular attention to the passages detailed in context below.

Whiting teaches the method of forming a resin layer in a mold on an exposed surface of a slate sheet thereby to bond with a veneer stratum thereof in order to render a flexible laminate for shaping by separating the veneer from the sheet. This disclosure is given in claims 1, 4, 5, 10 and 15 of the reference. The steps of placing a form around the sheet and inserting dams to define the shape for the resin layer essentially configure the resin mold of Whiting. The desired dimension of the slate precursor is achieved by placing the resin mold above the exposed surface to define the area of the bonded veneer, which is effectively the same as precutting the sheet. This disclosure can be found in the reference at lines 54-60 in column 4.

Whiting discloses the step of cleaving the slate veneer at lines 13-20 in column 6 and in Fig's 3 and 4. The cleaving step is described as a process of peeling. Whiting further teaches pouring the resin to apply it to the slate at line 14-20 in column 5. Whiting still further teaches that the resin can be partially cured, and specifically, can be further cured after the delaminating process at lines 40-45 in column 7.

Whiting teaches that a laminated slate precursor can be shaped by a mold surface at lines 30-35 in column 8 and in claims 4 and 5. The shapes mentioned by the reference include contoured shapes, such as columns and pillars. The application of

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pressure, as in the step of pressing, is inherent in the process of conforming a semi-rigid preform to a mold surface.

Whiting teaches the method of claim 1, as discussed above, and further teaches that the slate veneer has a thickness in the range 1/12 to 5 mm (0.003-0.197 inches) at lines 35-38 in column 6, which meets the requirement of claim 3 (0.063 inch).

Whiting teaches the method of claim 1, as discussed above, and further teaches shaping the precursor in a mold to conform to column shape, which indicates a single arc curve, at lines 30-35 in column 8, as required by claim 6.

Whiting teaches the method of claim 1, as discussed above, and further teaches trimming the laminated slate edges, as required by claim 8, at lines 24-29 in column 3 and in Fig 6.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiting.

Whiting teaches the method of claim 1, as discussed above, and further teaches that the polymer layer has a thickness of 5/6 to 6 mm (0.833-0.236 inches), but may have a larger thickness in an alternate configuration, at lines 40-45 in column 6. Claim 2 requires a thickness of ¼ inch (0.250). The taught and claimed values are close

enough that one skilled in the art would have expected them to have the same properties.

Whiting teaches the method of claim 1, as discussed above, and further teaches shaping the precursor by forming in a mold at lines 30-35 in column 8. While a single arc curve is mentioned, Whiting does not teach a wave-form shape, as required by claim 7. Such a shape involves inflecting and repeating a single arc curve, however, and would have been obvious as a matter of choice to one skilled in the art.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiting, as applied above for claims 1-3 and 6-8, and further in view of Ulrich (Article: Polyurethanes, "Encyclopedia of Polymer Science and Technology", Abstract), and further yet in view of the Data Sheet for Product Z-6644 (Development Associates, Inc).

Whiting teaches the method of claims 1-3 and 6-8, as discussed above, and further teaches that the resin is a polyurethane material at lines 8-12 in column 5. Whiting also teaches adding color to match slate color at lines 57-63 in column 5 and in claim 18, as required by claim 5.

Whiting does not teach mixing polyether polyol and diisocyanate, or mixing in the proportions of equal parts by weight, as required by claim 4.

Ulrich teaches that mixing polyether polyol and diisocyanate produces polyurethane. The Data Sheet, and the MSDS sheet for the product, show an exemplary commercial two-part mixture producing a suitable polyurethane product from equal A and B parts, which contain the same or equivalent ingredients as that specified by the claim.



Whiting and Ulrich are combinable because they are concerned with a similar technical field, namely, polyurethane. One of ordinary skill in the art at the time of the invention would have found it obvious to include in the method of Whiting the ingredients as taught by Ulrich, and would have been motivated to do so to produce a resin compound of choice.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whiting, as applied above for claims 1-3 and 6-8, and further in view of Stephens et al (U.S. Patent Publication 2003/0079438).

Whiting teaches the method of claims 1-3 and 6-8, as discussed above.

Whiting does not teach the use of sand bags to press the slate precursor to the mold surface, as required by claim 9.

Stephens et al, hereafter "Stephens", does use sand bags as a means for applying pressure in a mold in paragraph [009].

Whiting and Stephens are combinable because they are concerned with a similar technical field, namely, architectural materials. One of ordinary skill in the art at the time of the invention would have found it obvious to include in the method of Whiting the means for applying pressure to a perform in a mold, as taught by Stephens, and would have been motivated to do so in order to avoid the expense of fabricating a male form for the mold.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whiting, as applied above for claims 1-3 and 6-8, and further in view of Kropscott et al (U.S. Patent 3,789,100).

Whiting teaches the method of claims 1-3 and 6-8, as discussed above.

Whiting does not teach using Styrofoam sheets for dams to contain the resin, as required by claim 10.

Kropscott et al, hereafter "Kropscott", does teach using foamed polymers, and specifically styrenic compounds, as mold materials at lines 30-50 in column 1.

Whiting and Stephens are combinable because they are concerned with a similar technical field, namely, pour-casting. One of ordinary skill in the art at the time of the invention would have found it obvious to include in the method of Whiting the mold composition, as taught by Kropscott, and would have been motivated to do so because foamed materials are easier to shape than other mold materials.

### ***Conclusion***

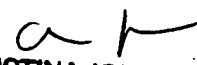
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Lambelet whose telephone number is 571-272-1713. The examiner can normally be reached on 8 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEL

  
CHRISTINA JOHNSON  
PRIMARY EXAMINER  
6/12/06